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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/699,984

11/03/2003

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SONYJP 3.0-346

5312

530 7590 11/24/2009  
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EXAMINER

JOHNS, CHRISTOPHER C

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

11/24/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/699,984	<b>Applicant(s)</b> AIDA ET AL.	
	<b>Examiner</b> Christopher C. Johns	<b>Art Unit</b> 3621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Acknowledgements***

1. This Office Action is given Paper No. 20091119 for reference purposes only.
2. This Office Action is in response to the Request for Continued Examination, filed by Applicants on 12 November 2009.
3. All references to the capitalized version of “Applicant” refer specifically to the Applicants of record in the instant application. Any references to lowercase versions of “applicant” or “applicants” refer to any or all patent applicants. Unless expressly noted otherwise, references to the capitalized version of “Examiner” refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally. The notations in this paragraph apply to any future Office actions from this Examiner.
4. Claims 1 and 6 are pending.
5. Claims 1 and 6 have been examined.

### ***Continued Examination Under 37 CFR 1.114***

6. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 November 2009 has been entered.

***Claim Objections***

7. Claim 6 is objected to because of the following informalities: page 4, line 26 reads “second time so as request”. It is believed that this phrase is supposed to be “so as to request” (as in claim 1). Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. In claim 1, claim elements “first requesting means” “second requesting means” and “third requesting means” are means plus function limitations that invoke 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure or material to the claimed function such that one of ordinary skill in the art would recognize what structure or material, or acts perform the claimed functions. The specification appears to only disclose one “communication unit” (figure 4, reference 79). The Examiner has made the assumption that this is one of the “requesting means” used by Applicants to fulfill their obligations under 35 U.S.C. 112 6th paragraph; however, the existence of three separate requesting means is not present in the written description of the invention.

11. It is recommended, in the interest of compact prosecution, that Applicants clearly indicate where the support for the “means for” recitations are found.

12. Claim 1 contains a number of other “means for” clauses (“registering means”, “providing means”, “generating means”, and “transferring means”) whose support cannot be explicitly discerned from the instant application’s original filing.

13. Claim 6 suffers from similar deficiencies, especially “software requesting means”, “receiving means”, and “license requesting means”.

14. Applicant is required to:

- a. Amend the claim so that the claim limitation will no longer be means plus function limitations under 35 U.S.C. 112, sixth paragraph; or
- b. Amend the written description of the specification such that it clearly links or associates the corresponding structure or material to the claimed functions without introducing any new matter (35 U.S.C. 132(a)).

15. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though claims may be indefinite, the claims are construed and the prior art is applied as much as practically possible.

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent 6,732,106 (“Okamoto”).

18. As per claims 1 and 6, Okamoto discloses:

19. server programmed to provide software via a network in response to a request to purchase or transfer the same (figure 10, reference 1003);

20. at least two electronic devices, each of the at least two electronic devices being identified by device identification information registered in association with user identification information identifying a single user such that each of the at least two electronic devices have the same user associated therewith (figure 10, reference 1002);

21. each of the at least two electronic devices including first requesting means for sending the user identification information and the device identification information for the respective electronic device, and software identification information for selected software, to the server to request that the selected software be provided (figure 10, reference 1016);

22. installing means for installing the selected software provided from the server after the first requesting means has sent the user identification information and the device identification information for the respective electronic device, and the software identification information for the selected software, to the server a first time (figure 10, reference 1020);

23. running means for running the selected software using the license (figure 10, reference 1022);
24. means for causing information to be supplied to the respective electronic device which identifies each electronic device currently available to receive the selected software by transfer if a request to do so is made (figure 26, step S2611);
25. third requesting means for requesting that the server transfer the selected software from the respective electronic device to another of the at least two electronic devices which has the same user associated therewith as that of the respective electronic device and which is selected by use of the information which identifies said each electronic device currently available to receive the selected software by transfer (figure 8, “Choose a download device”);
26. the server including registering means for registering the software identification information for the selected software in association with the user identification information and the device identification information for the respective electronic device on condition that the user identification information and the device identification information for the respective electronic device have been registered in association with each other (figure 20 - “User ID”, “System name”);
27. providing means for providing the selected software to the respective electronic device (figure 10, reference 1013);
28. generating means for generating the license when the software identification information for the selected software, the user identification information, and the device have been registered in association with each other (figure 10, reference 1014 - see figure 28, reference S2807 for the data that is sent);

29. transferring means for, upon a request by the third requesting means of the respective electronic device to transfer the selected software to the another electronic device, providing the information which identifies said each electronic device currently available to receive the selected software by transfer to the respective electronic device to enable a selection (figure 31, reference S3106),

30. deleting the software identification information for the selected software and the user identification information and the device identification information registered in association with the software identification information for the respective electronic device (figure 31, reference S3112),

31. registering the software identification information for the selected software in association with the device identification information for the another electronic device and the user identification information (figure 25, reference S2505), such that the respective electronic device is prohibited from purchasing software and such that the another electronic device is allowed to run the selected software (figure 31, reference S3112).

32. Okamoto discloses as above, but does not explicitly disclose:

33. sending the software identification information for the selected software, the user identification information, and the device identification information for the respective electronic device to the server a second time so as to request that a license required to run the selected software be generated based on predetermined license generating information and be provided to the electronic device.



34. However, if not inherent, then it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Okamoto to include separate steps for performing similar (as well as highly-interwoven) functionality. It is the Examiner's finding and position that absent evidence of new or unexpected results, it is not inventive in terms of patentability to take one or more steps ( $S_1, S_2, S_3, \dots S_N$ ) which perform one or more tasks ( $T_1, T_2, T_3, \dots T_N$ ) and add (or subtract) an additional number of steps ( $X$ ) to perform all or part of the same tasks by allocating the tasks between the various steps (i.e.  $S_1$  performs the 1<sup>st</sup> part of  $T_1$ ;  $S_2$  performs the 2<sup>nd</sup> part of  $T_1$ ; ... while  $S_N$  performs the first part of  $T_N$  and  $S_{N+1}$  performs the 2<sup>nd</sup> part of  $T_N$ ). The prior art is replete with examples showing why user various client server configurations are desirable<sup>1</sup>.

35. In other words, a modification distributing the tasks between various steps (e.g. having multiple steps perform the actions previously performed by a single step) is analogous to making functionality or actions separable. In this exact situation, it would have been obvious to one of

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<sup>1</sup> See e.g. Watson (United States Patent 6,223,209 B1) disclosing distributed satellite world wide web servers containing identical information placed strategically throughout the Internet so as to be close to all potential clients to help reduce traffic bottlenecks; Midgely et. al. (United States Patent 5,592,611 A) disclosing additional servers as a stand-in for a failed server so that client service requests are transparent to the user; Kriegsman (United States Patent 6,370,580 B2) disclosing multiple servers as secondary web servers to optimize file transfers; Burns et. al. (United States Patent 6,298,373 B1) disclosing cache servers which download content during off-peak hours to reduce traffic bottlenecks; Stiles (United States Patent 6,219,692 B1) which discloses sending essentially identical tasks to multiple servers with differing processing loads to find the most preferred server provider; Zdepski et. al. (United States Patent 5,825,884) disclosing an transactional server for TV networks; Burns et. al. (United States Patent 6,298,373) disclosing how computers are used at clients to increase bandwidth by providing content in downloaded from other computers; How Networks Work (2000, ISBN: 0789724456, Derfler et al), Chapter 17 describing how server based structures benefit from economies of scale in addition to offering security, excellent data management, fast response, and room for expansion; and How the Internet Works (2006, ISBN: 0789736268, Gralla, Preston), Chapter 44 implementing a server based architecture in Internet e-commerce.

ordinary skill in the art at the time of the invention to split the step of acquiring the digital content and the license into two steps. This would create a more convenient system for its users; by accomplishing the acquisitions in two separate steps, the failure of either step would not require a complete rerunning of the full step - instead, only the half-step (either acquiring the license or acquiring the data) would be necessary. This would create a more convenient system for its users, leading to a more profitable system for its creators because users are more likely to buy and use a convenient system.

36. Therefore, it is the Examiner's position that when the difference between the claimed invention and the prior art is that the prior art does not explicitly disclose an element as separable, then as a matter of law, it would have been obvious to one of ordinary skill in the art at the time of the invention to make the element separable. See also *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961), and MPEP §2144.04. In the instant case, it would also have been obvious to one of ordinary skill in the art at the time of the invention to split the one step of acquiring the license and data into two steps, in order to create a more convenient (for its user) and profitable (for its creators) system.

### ***Response to Arguments***

37. Applicants' arguments with respect to the claims have been considered but are moot in view of the new ground of rejection. They argue limitations that were not previously in the claims – as they have been fully addressed in this Office Action, the arguments are overcome.

### ***Conclusion***

38. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462.

The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

39. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

40. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher C Johns/  
Examiner, Art Unit 3621

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685